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10/092,878	03/06/2002	Michael R. Schramm		2526

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EXAMINER

LAMB, BRENDA A

ART UNIT PAPER NUMBER

1734

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/092878

Applicant(s)

Schramm

Examiner

LAMB

Group Art Unit

1734

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 7/19/2004 and 6/04/2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 21-46 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 21-46 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6/08/2002
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Applicant's argument in the response of 7/19/2004 with regard to the restriction requirement was persuasive and the restriction requirement is withdrawn.

Claims 21-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 22, 28 and 46 that work piece defines at least one work piece from following group of workpieces consisting of: a colorable work piece, a substantially egg shaped workpiece, and edible workpiece, a substantially egg shaped edible work piece, and an egg is confusing since these work pieces are not mutually exclusive, for example, the egg is an edible workpiece. The recitation in claim 22, 40 and 46 that the at least one colorant of the consisting of a predetermined quantity of powdered colorant, a discrete unit of colorant concentrate, a colorant pill, and a colorant pill defining a colorant powder concentrate enclosed within a liquid soluble container is confusing since these colorants are not mutually exclusive, for example, since a colorant pill defining a colorant powder concentrate enclosed within a liquid soluble container is a colorant pill. The recitation in claims 21, 28, 34, 40 and 46 that "said container defines a container" is confusing since it infers more than one container and the specification and drawings show only one container.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-25, 27-31, 33-37, 39-43 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,386,138 (hereinafter referred to as Schramm '138). Although the conflicting claims are not identical, they are not patentably distinct from each other because Schramm '138 claims an apparatus/kit comprising the combination of a container, at least one workpiece, at least one utensil, and a colorant, wherein the container defines an inner cavity and a funnel is connected to the opening to provide communication between the inner cavity and an exterior of the container, and wherein the workpiece, the utensil are at least partially removably contained within the container. Schramm '138 fails to claim its colorant, a discrete unit or volume of colorant, is at least partially removably contained within the container. However, it would have been obvious the colorant in the Schramm '138 kit is at least partially removably contained within the container dependent on the volume/level of the colorant in the container. Thus claims 21-22 are obvious over Schramm '138. With respect to claim 28, Schramm '138 claims apparatus/kit is comprised of the combination of a container and at least one workpiece, wherein the container defines a container having an inner cavity, an exterior, an opening in a wall of the container and a funnel connected to the opening to provide communication between the inner cavity and the exterior of the container, and

wherein the workpiece are at least partially removably contained within the container.

Schramm '138 claims wherein the work piece defines at least one workpiece of the following group of workpieces consisting of a substantially egg shaped work piece, and edible work piece, a substantially egg shaped, edible work piece, and an egg. With respect to claim 34, Schramm '138 claims apparatus/kit is comprised of the combination of a container and at least one utensil, wherein the container defines an inner cavity, an exterior, an opening in a wall of the container and a funnel connected to the opening to provide communication between the inner cavity and the exterior of the container, and wherein the utensil are at least partially removably contained within the container.

Schramm '138 claims wherein the at least one utensil consisting of a brush, a spoon, a wire eggs dipper, a pair of tongs, and a straw. With respect to claim 40, Schramm '138 teaches the colorant is a discrete unit or volume of colorant within the container.

Schramm '138 fails to claim the colorant is at least partially removably contained within the container. However, it would have been obvious the colorant in the Schramm '138 kit is at least partially removable to remove the article with colorant thereon from the container and dependent on the volume/level of the colorant in the container. With respect to claim 23, 29, 35 and 41, Schramm '138 claims a transparent container. With respect to claim 24, 30, 36 and 42, Schramm '138 claims the container comprising a first member and a second member and wherein the first member is sealingly and detachably engageable to the second member. With respect to claim 25, 31, 37 and 43, Schramm '138 claims the container defines a container consisting of a formed plastic sheet. With respect to claims 27, 33, 39 and 45, Schramm '138 claims the

container resists the spillage of liquid contents which obviously are the non-gaseous fluid contents of the container when the container is oriented in any orientation.

Claims 22, 40-43 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,386,138 (hereinafter referred to Schramm '138) in view of Growe et al.

Schramm '138 claims an apparatus/kit comprising the combination of a container, at least one work piece, at least one utensil, and a colorant, wherein the container defines an inner cavity, an exterior, an opening in a wall of the container and a funnel connected to the opening to provide communication between the inner cavity and the exterior of the container, and wherein the workpiece, the utensil are at least partially removably contained within the container. Schramm '138 fails to claim the colorant is at least partially removably contained within the container and the colorant is a predetermined powder or granular colorant. However, it would have been obvious the colorant in the Schramm '138 kit is at least partially removable to remove the article with colorant thereon from the container and dependent on the volume of the colorant in the container. Further, it would have been to provide the colorant in the Schramm '138 kit in the form of a granular or powder material since Growe et al teaches a kit for dyeing eggs wherein the granular or powder material is provided within the dyeing receptacle for the obvious reason such increasing the ease of transporting the kit without the risk associated with spillage of the liquid and reducing the weight of the transported kit without the liquid. Thus claims 40 and 22 are obvious over the above-cited references. With respect to claim 23 and 41, Schramm '138 claims a transparent container. With

respect to claim 24 and 42, Schramm '138 claims the container comprising a first member and a second member and wherein the first member is sealingly and detachably engageable to the second member. With respect to claim 25 and 43, Schramm '138 claims the container defines a container consisting of formed a plastic sheet. With respect to the claim 27 and 45, Schramm '138 claims the container resists the spillage of liquid contents which obviously are the non-gaseous fluid contents of the container in any orientation of the container.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 40, 42 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain 1,428,356 (Hunter).

Hunter teaches a kit comprising the combination of a container and a colorant, paint, contained within the container wherein the container defines a container having an inner cavity, and exterior, and opening in a wall of the container and a funnel connected to the opening to provide communication between the inner cavity and the exterior of the container. Hunter teaches the colorant in the kit consists of a discrete unit of colorant concentrate or paint. Thus claim 40 is Hunter teaches every element of the kit. With respect to claim 45, Hunter teaches the container resists the spillage of non-gaseous fluid content of the container in any orientation of the container (see page 3 line 63 to page 4 line 3). With respect to claim 42, Hunter container comprises a first member and a second member and wherein the first member is sealingly and detachably engageable to the second member (see page 3 lines 26-32 and Figures 1 and 5).

Claims 28-31, 33-37, 39, 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter.

Hunter is applied for the reasons noted above. Hunter teaches that his container may be used to contain granular material or contain small parts for an assembly line or may contain paint in combination with an applicator (a paint brush). Hunter fails to teach his fails to his container in combination with a utensil within the scope of claim 34 or workpiece within the scope of claim 28. However, it would have been obvious provide his container in combination with a utensil within the scope of claim 34 or workpiece within the scope of claim 28 since Hunter infers at page 3 line 30 to page 4 line 3 that his container may be used in combination with other elements known to be used in an



assembly line such colorable workpiece and pair of tongs. However or and teach the container is container is plastic. With respect to claims 31, 37 and 43, Hunter fails to teach the container is formed from plastic. However, it would have been obvious to one skilled in the art to construct the Hunter container from plastic since it has been held to within the general of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With respect to claims 29, 35 and 41, Hunter fails to teach the container is transparent but obvious to do so enable the user to determine characteristics of the material therein. With respect to claims 30 and 36, the same rejection applied to claim 42 is applied here. With respect to claims 33 and 39, the same rejection applied to claim 45 is applied here.

Claims 29, 35 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Lintvedt.

Hunter is applied for the reasons noted above. Hunter fails to teach the container is transparent. However, it would have been obvious to modify the Hunter container from a material such that it is transparent that but obvious to do so for the advantages taught by Linstvedt of using a transparent container - enables the user to discern characteristics of the contents within the transparent container such as color.

Claims 28, 30, 33, 40, 42 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 11-227388.

Japan '388 teaches a kit comprising the combination of a container and a colorant, paint, contained within the container and a colorable workpiece, brush 8, being

colored with the colored ink wherein the container having an inner cavity, and exterior, an opening in a wall of the container and a funnel connected to the opening to provide communication between the inner cavity and the exterior of the container. Japan '388 teaches the colorant in the kit consists of a discrete unit of colorant concentrate or colored ink. Thus Japan '388 teaches each of the elements in the kit of claims 28 and 40. With respect to claims 33 and 45, Japan '388 teaches the container resists the spillage of non-gaseous fluid contents of the container when the container is oriented in any orientation (also see Japan '388 Figures). With respect to claims 30 and 42, Japan '388 container comprises a first member and a second member and wherein the first member is sealingly and detachably engageable to the second member (see Figures 2-8 and 8-9).

Claims 29, 31, 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 11-227388.

Japan '388 is applied for the reasons noted above. Hunter fails to teach the container is plastic. However, it would have been obvious to one skilled in the art to construct the container from plastic since it has been held to within the general of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Thus claims 31 and 43 are obvious over Japan '388. With respect to claims 29 and 41, Japan '388 fails to teach the container is transparent but obvious to do so enable the user to determine characteristics of the material therein.

Claims 29 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 11-227388 in view of Lintvedt.

Japan '388 is applied for the reasons noted above. Japan '388 fails to teach the container is transparent. However, it would have been obvious to modify the Japan '388 container from a material such that it is transparent that but obvious to do so for the advantages taught by Linstvedt of using a transparent container - enables the user to discern characteristics of the contents within the transparent container such as color.

Claims 26, 32, 38 and 44 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

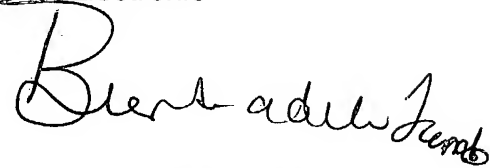
Claim 46 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

The prior art made of record and not relied upon is considered pertinent to applicant disclosure: Galer teaches the taught advantages of using plastic container to contain paints.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday Wednesday thru Friday with alternate Tuesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "Brenda A. Lamb".

BRENDA A. LAMB  
PRIMARY EXAMINER